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| NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 | | | BROOKS, CLINTON A | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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ARLINGTON VA 22203

In re Application of :
Leblond et al. :
Serial No.: 10/581,947 :Decision on Petition
Filed: June 6, 2006 :
Attorney Docket No.: **BJS-3665-181** :

This letter is in response to the petition filed under 37 C.F.R. § 1.144 filed on August 6, 2010 to review the examiner's withdrawal of claims 34 and 35 from consideration.

BACKGROUND

On August 26, 2009, the examiner divided claim 22-41 into 14 Groups based upon variables of the Markush claim.

The inventions listed as Groups 1-14 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common core lacks unity of invention because it is known in WO 2001/056358 with RN 1168807-04-2 which has the same core as instantly claimed with a different utility of a pesticide. Due to this, unity of invention is lacking.

Applicants were also advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

On September 25, 2008, applicants filed a bona fide response and elected, with traverse, the subject matter of Group 13. A species was also elected.

On October 28, 2009, the examiner mailed to applicants a non-final Office action. The examiner addressed the traversal and made the requirements final. Claims 23, 26 and 31 were withdrawn as being directed to non-elected invention. Claims 22, 24-25, 27-30 and 32-41 were examined to the extent that they read on the elected species. The examiner also stated that the elected species was free of the prior art. The claims were also rejected under 35 USC 112, second paragraph, USC 112, first paragraph, 35 USC 102, and 35 USC 103.

On February 1, 2010, applicants submitted claim amendments and arguments traversing the rejections set forth in the non-final of October 28, 2009.

On May 7, 2010, the examiner mailed to applicants a final Office action. Claims 23-26, 28, 34 and 35 were withdrawn as being directed to non-elected invention. Claims 22, 27, 29-33 and 36-41 were rejected. The claims were rejected under USC 112, first paragraph and 35 USC 102.

On August 6, 2010, applicants submitted the petition currently under review.

DISCUSSION

The petition and file history have been carefully considered.

Applicants argue that "claims 34 and 35 were indicated in the previous Office Action dated October 28, 2009 as reading on the elected species and were examined. See page 2 of the Office Action dated October 28, 2009. Neither claims 34 nor 35 were amended in the Amendment of January 28, 2010 or the Supplemental Amendment of February 1, 2010 - which were filed in response to the Office Action of October 28, 2009 - such that the Examiner's withdrawal of the claims from consideration, for the first time in the final Office Action of May 7, 2010, is not appropriate or justified. The Examiner comments on page 2 of the Office Action dated May 7, 2010, that "claims 23-26, 28, and 34-35 are withdrawn from consideration pursuant to Markush practice as not being anticipated by the art below." are unclear as a basis for withdrawing the claims from consideration. The Examiner appears to have withdrawn admitted novel claims from consideration because they are novel over the cited art. Moreover, as claims 36-41 and new claim 42 depend from claim 34, the status of these dependent claims is uncertain in view of the Examiner's withdrawal of claim 34 from consideration."

Applicants' argument has been carefully considered and is persuasive that the record is uncertain. The examiner has limited the scope of the claims under examination to the elected species and closely related species. This is problematic for three reasons.

First, the examiner has withdrawn from consideration claims 34-35 which encompass the elected species which is counter to MPEP 818, which states: "Applicant must make his or her own election; the examiner will not make the election for the applicant. 37 CFR 1.142, 37 CFR 1.143."

Second, it is unclear which closely related species has or have been examined. The Office action only addresses the merits of the elected species. There is no rejection or, conversely, indication of allowability for any closely related species. The "closely related species" are not identified.

Third, 35 USC 121 permits the Office to require an election of species for prosecution on the merits, to which the claims shall be restricted if no generic claim is finally held to be allowable. Maintaining a restriction requirement amongst species is only proper if it is predicated upon a rejection under 35 USC 101, 102, 103 or 112 1st paragraph. In this instance, because there are no outstanding rejections, the examiner should have followed practice set forth in MPEP 803.02 and

examined a second and/or subsequence species in order to determine the patentability of the Markush claim.

However, this was not done. In the non-final Office action mailed October 28, 2009, the examiner indicated that the elected species was free of the prior art. MPEP § 803.02 states in part:

“...should the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a *nonelected species*, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species.”

DECISION

The petition is **GRANTED** for the reasons set forth above.

Should the examiner find prior art on a second or subsequence species, per MPEP 803.02, the election of species requirement would be maintained.

The Office action of May 7, 2010 is withdrawn as incomplete, because there is no rejection under 35 USC 101, 102, 103 or 112 over the elected species, nor is there any rejection under 35 USC 101, 102, 103 or 112 over a second or subsequent embodiment in Markush claim, nor are claims encompassing the elected invention indicated as in condition for allowance. Moreover, the methods of making and using the elected product have not been examined.

The application will be forwarded to the examiner for preparation of a supplemental non-final Office action consistent with this decision per guidance in MPEP 803.02 and 821.04(b).

Should there be any questions about this decision, please contact Quality Assurance Specialist Marianne Seidel, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Remy Yucel
Director, Technology Center 1600